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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,877	03/23/2001	Takashi Morishita	2804-0102P	9853

2292 7590 09/10/2003

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EXAMINER

SOWARD, IDA M

ART UNIT	PAPER NUMBER
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2822

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/787,877

Applicant(s)

MORISHITA ET AL.

Examiner

Ida M Soward

Art Unit

2822

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003 .
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-36 and 44-59 is/are allowed.
- 6) ☒ Claim(s) 1 and 6-8 is/are rejected.
- 7) ☒ Claim(s) 2-5 and 37-43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 30 June 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **DETAILED ACTION**

This Office Action is in response to the Applicants' amendment filed June 30, 2003.

### ***Priority***

Acknowledgement is made to the PCT/JP99/05231 received May 10, 2001.

### ***Drawings***

The objection to the drawings under 37 CFR 1.83(a) has been withdrawn due to the amendment filed.

The objection to the drawings as failing to comply with 37 CFR 1.84(p)(5) has been withdrawn due to the amendment filed.

### ***Specification***

The objection to the abstract has been withdrawn due to the amendment filed.

### ***Claim Objections***

The objection to claims 35-36 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim has been withdrawn due to the amendment filed.

The objection to claims 36, 38-43 and 49 under 37 CFR 1.75(c) as being in improper form because a multiple dependent claims reference claims to different features has been withdrawn due to the amendment filed.

### ***Claim Rejections - 35 USC § 112***

The rejection of claims 1, 8 and 37 under 35 U.S.C. 112, second paragraph, has been withdrawn due to the amendment filed.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 6-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 8-10 of U.S. Patent No. 6,528,387 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because a semiconductor substrate comprising an insulating underlay is the same as an SOI substrate comprising an insulating base; 7

Art Unit: 2822

$\times 10^6 / \text{cm}^2$  or less is in the range of not more than  $4 \times 10^8 / \text{cm}^2$ ; 0.05 nm to 2 nm is the range of not more than 4 nm but not less than 0.05 nm; 0.03  $\mu\text{m}$  to 0.7  $\mu\text{m}$  is the same as in U.S. Patent No. 6,528,387 B1, claim 10; and a multi-layered substrate is similar to a laminated substrate.

Claims 37-43 are objected to as being dependent upon a double patenting rejected base claim.

#### ***Allowable Subject Matter***

Claims 2-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 9-36 and 44-59 are allowed.

#### ***Response to Arguments***

Applicant's arguments filed 06-30-03 have been fully considered but they are not persuasive. Again, although the conflicting claims are not identical, they are not patentably distinct from each other because a semiconductor substrate comprising an insulating underlay is the same as an SOI substrate comprising an insulating base;  $7 \times 10^6 / \text{cm}^2$  or less is in the range of not more than  $4 \times 10^8 / \text{cm}^2$ ; 0.05 nm to 2 nm is the range of not more than 4 nm but not less than 0.05 nm; 0.03  $\mu\text{m}$  to 0.7  $\mu\text{m}$  is the same

as in U.S. Patent No. 6,528,387 B1, claim 10; and a multi-layered substrate is similar to a laminated substrate.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ida M Soward whose telephone number is 703-305-3308. The examiner can normally be reached on Monday - Thursday, 6:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amir Zarabian can be reached on 703-308-4905. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

ims  
August 28, 2003



AMIR ZARABIAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800